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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,425	07/27/1999	JOHN KUNG	JBP461	5503

7590 01/28/2003

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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 01/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/361,425

Applicant(s)

KUNG ET AL.

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Request for Continued Examination (RCE) filed on December 17, 2002 (Paper No. 28) under 37 CFR 1.114 is acknowledged. An action on the RCE follows.

#### ***Status of the Claims***

2. Claims 7, 14-24 are pending.

Applicants' amendment filed on December 17, 2002 (Paper No. 29) is acknowledged, and applicants' response has been fully considered. Claims 7, 17-19 and 21-24 have been amended, claims 14 and 16 stand withdrawn from consideration. Thus, claims 7, 15 and 17-24 are examined.

#### **Rejection Withdrawn**

#### ***Claim Rejections - 35 USC § 112***

3. The previous rejection of claims 7, 17, 18 and 21-24 under 35 U.S.C.112, second paragraph, is withdrawn in view of applicants' amendment to the claim, and applicants' response at pages 4-7 in Paper No. 29.

#### ***Claim Rejections - 35 USC § 102***

4. The previous rejection of claims 7, 15 and 21 under 35 U.S.C.102(b), as being anticipated by Malfroy-Camine *et al.* (U. S. Patent 5,403,834) is withdrawn in view of applicants' amendment to the claim and applicants' response at pages 8-9 in Paper No. 29.
5. The previous rejection of claims 7, 15 and 23 under 35 U.S.C.102(b), as being anticipated by Bland (U. S. Patent 5,637,324) is withdrawn in view of applicants' amendment to the claim and applicants' response at pages 8-9 in Paper No. 29.

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6. The previous rejection of claims 7, 15, 18 and 21 under 35 U.S.C.102(a), as being anticipated by Cruz (U. S. Patent 5,843,481) is withdrawn in view of applicants' amendment to the claim and applicants' response at page 9 in Paper No. 29.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 7 is indefinite because a retinoid and one to three oxygen-labile species which also includes a retinoid are contained in the composition, it is not clear whether the two retinoids are the same or different as to the "a retinoid" (line 2, clean copy) and "a retinoid" (line 3, first recited member of the Markush group).

9. Claim 15 is indefinite because the claim recites "compositions comprising from about one to about three oil-soluble oxygen-labile species", however, it also cites "the compositions comprises at least one retinoid, at least one tocopherol and at least ascorbic acid", it is not clear whether the composition comprises one or two oil-soluble oxygen-labile species. Claim 15 is also indefinite because of the use of the term "derivatives", it is unclear what structure the derivative has, and how different the derivative is as compared to the parent compound. A Markush group is a closed group. The "...their derivatives..." is not specific as to what each derivative is or is not supposed to have been which derivatives are included or excluded from the recitation.

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In response, applicants indicate the claim has been amended to cite classes of compounds such as a retinoid, an ascorbic acid and a tocopherol. However, claim 15 has not been amended and still contains the term "derivative", which absent factual evidence to the contrary, is any compound.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent; or,

10. Claims 7, 15, 17-24 are rejected under 35 U.S.C. 102(a) as being anticipated by Jiang *et al.* (J. Nutritional Biochemistry 9, 362-369 (July 1998)).

Jiang *et al.* teach the synergistic effect of dehydroepiandrosterone (DHEA) and antioxidant nutrients to mice, where the antioxidant nutrients contain mixture of L-ascorbic acid (0.3 mg/g corresponding to 0.03%), D- $\alpha$ -tocopherol (1.5 mg/g corresponding to 0.15%), N-acetylcysteine (0.3 mg/g corresponding to 0.03%), retinol (0.08 mg/g corresponding to 0.008%), L-carnitine (0.3 mg/g corresponding to 0.03%), and bioflavanoid (0.3 mg/g corresponding to 0.03%) (page 363, right column, first paragraph; claims 7, 15, 17-24). The amount of retinol in the composition is 0.008%, which is about 0.01% (claims 22-24), and L-carnitine is a known fatty acid binder (claim 21).

11. Claims 7 and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Fisher *et al.* (WO 98/55075).

Fisher *et al.* teach a composition for ameliorating various effects of UV radiation comprising effective amounts of retinoid and antioxidants such as ascorbic acid and N-acetylcysteine (page 5, lines 1-4; page 15, line 27-page 16, line 32; claims 1, 3, 4, 10 and 14 of WO 98/55075), which meets the criteria of claims 7 and 20.

In response, applicants indicate the reference only mentions retinoids, ascorbic acid and N-acetylcysteine as potential MMP inhibitors, it does not propose the formulation described by the amended claim (page 9 of the response). The argument is not persuasive because claims 10 and 14 of the reference recite the composition containing retinoid in addition to N-acetylcysteine and ascorbic acid.

### ***Conclusion***

12. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

*Christopher S. F. Low*  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

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January 23, 2003